

REMARKS

Applicants have amended the claims in order to further clarify the claim language. The amendment should not be construed as further limiting the scope of the claims.

Claim 10 and claims dependent thereon were rejected under 35 USC § 112. Applicants have deleted element (e) and new element (e) has been clarified by adding the term "the central receiving agency". Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 2-10 were rejected under 35 USC 103(a) as being unpatentable over Lockhart et al. (USP 6,732,152) in view of Fredlund et al. (USP 5,666,215). The rejection of the claims was discussed in a personal interview granted to the undersigned attorney. It is submitted that the claims distinguish of the cited references for the reasons set forth below.

Element (a) of claim 10 requires that the consumer electronically transmitting digital image and demographic information identifying the consumer or recipient. In discussing Lockhart et al. with respect to this claim feature, the examiner states "A consumer may also upload demographic information that identifies the consumer or recipient; see, for example, at least references to demographics, Col. 15, lines 46-54". Lockhart et al., however, actually states "Indeed, the advertisements may be based on precise demographic data derived in part from the recipient's address information." Emphasis added, col. 15, lines 53-55. Thus, the only reference to demographic data in Lockhart et al. is demographic data derived from address information entered by the consumer. Lockhart et al. therefore does not disclose or suggest having a consumer enter demographic information as required in element (a) of claim 10.

The examiner may suggest that the address information of the recipient constitutes demographic data. In order to clarify the difference between demographic data and address information, applicants have amended claim 10 to point out that the consumer information entered by the consumer includes both recipient location information and demographics information. Accordingly, the address information disclosed in Lockhart et al. does not constitute demographic information as stated by the examiner.

Even if address information were considered demographic information, however, Lockhart et al. fails to disclose or suggest other elements of the claims at issue. Claim 10, for example, also requires that the central receiving agency merge into a digital image file the consumer identified digital image(s) and the corresponding selected sponsor digital image(s). The examiner states "Lockhart discloses merging into a digital file the consumer identified digital image and the corresponding sponsor digital images. See, for example, at least references to merging consumer images and sponsor images and text, at least Col. 10, lines 56-67." In fact, there is no disclosure or suggestion at the cited location to merge sponsor selected digital images with consumer selected images. Instead, the paragraph generally refers to merging "...variable text or variable data (addresses, names, etc.)..." than can be "...incorporated into the final mail item's text note." Thus, the cited paragraph appears to be discussing only text information.

Applicants note other portions of Lockhart et al. discuss allowing the user to select image information that is to be incorporated in the mail file. For example, Lockhart et al. states "In addition to suitable communication software, user system 102 may also include client software which allows the user to select regions of the displayed image for inclusion in the mail file and, ultimately, the printed mail item." Col. 4, lines 53-56. See also, col. 6, lines 52-56, which states in part "...mail service computer 10 which includes a plurality of graphical images that the user may select...". In each case, however, the images are always selected by the user and not selected by the sponsor.

The only reference to sponsor images in Lockhart et al. is the description of the "Peel-off Covers and Sponsored Mail" discussed at col. 15, lines 36. Lockhart et al. describes printing sponsor images on an opaque cover that is placed on top of the printed mail item. Thus, while Lockhart et al. does disclose a combined cover and mail item on which both sponsor images and consumer images may be found, there is no disclosure or suggestion in Lockhart et al. to merge consumer selected images with sponsor selected images into a digital image file. Accordingly, Lockhart et al. fails to disclose or suggest element (e) of claim 10.

Since Lockhart et al. fails to disclose or suggest the creation of a merged digital image file as required by element (e) of claim 10, it must also fail to

disclose or suggest transmitting such a file or printing such a file as set forth in elements (f) and (g) of claim 10.

Applicants note the examiner has not cited any references in combination with Lockhart et al. with respect to the rejection of claim 10. As Lockhart et al. clearly fails to disclose or suggest many of the elements set forth in the claim, this sole reference cannot form the basis for finding claim 10 prima facie obvious under 35 U.S.C. § 103. Absent such a finding, the claim is allowable over the art of record in accordance with the provisions of the Code.

Claims 2-9 depend on claim 10 and should be allowed for the same reasons set forth above with respect to claim 10. Claim 7 was further rejected in view of Fredlund et al., but this secondary reference fails to overcome the deficiencies of Lockhart et al. set forth above. Accordingly, claims 2-9 are also believed to be in condition for allowance.

Applicants respectfully request that the current rejection of the claims be reconsidered and withdrawn. Further, unless the examiner is able to find additional prior art that is more relevant than the art already of record, applicants submit that the application should be passed to issuance without further delay.

It is believed that these changes now make the claims clear and definite and, if there are any problems with these changes, the undersigned attorney would appreciate a telephone call at 703-726-6020.

It is noted that the undersigned attorney is now of record in view of the Authorization to Act in a Representative Capacity included with this amendment.

Respectfully submitted,

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MAR:plr

Enclosure: Authorization to Act in Representative Capacity